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**SEP 27 2010**

**OFFICE OF PETITIONS**

ELAN DRUG DELIVERY, INC. C/O FOLEY & LARDNER  
3000 K STREET, N.W.  
SUITE 500  
WASHINGTON DC 20007-5109

In re Patent No. 7,713,551 : DECISION ON REQUEST  
McGurk et al. : FOR  
Issue Date: 05/11/2010 : RECONSIDERATION OF  
Application No. 10/659,706 : PATENT TERM ADJUSTMENT  
Filing or 371(c) Date: 09/11/2003 :  
Atty Docket No. :  
029318-0968 :

This is a decision on the petition filed on June 16, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred seventy-eight (578) days.

The petition to correct the patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of four hundred twenty-eight (428) days.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on September 12, 2006, and ends on August 16, 2007, the day before the RCE was filed, and is 339 days. See 35 U.S.C. 154(b)(1)(B)(i). Any time consumed by appellate review, however, is not included in the calculation of 37 CFR 1.702(b). See 35 U.S.C. 154(b)(1)(B)(ii). On March 20, 2007, a notice of appeal was filed. On August 17, 2007, the RCE was filed. Accordingly, the excluded period for appeal is 150 days, and the "B" delay period is 189 (339 – 150) days.

Petitioners' argument that there should be no reduction for appellate review because "there was no appellate review by the Board; no Brief on Appeal was ever filed," has been considered, but is not persuasive. In this regard, 37 CFR 1.703(b)(4) states:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and

ending on the date a patent was issued, but not including the sum of the following periods: The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

It is undisputed that on March 20, 2007, a notice of appeal was filed. Further, the RCE was filed on August 17, 2007, prior to the date of mailing of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. Accordingly, the period from the filing of the notice of appeal on March 20, 2007, until the day prior to the filing of the date the RCE was filed is excluded from the calculation of the period of adjustment under § 1.702(b).

Accordingly, no change will be made to the patent term adjustment of 428 (437 days Office delay + 189 days three years delay – 198 days of applicant delay) days indicated on the face of the issued patent.

Further, it is noted that although a fee was submitted with the petition filed on December 28, 2009, a separate \$200.00 fee as set forth in 37 CFR 1.18(e) is required for the subject petition under 37 CFR 1.705(d). The fee is being charged to counsel's deposit account.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.



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Office of Petitions